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Bart Munro

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MINNEAPOLIS, MN 55402

EXAMINER

THERIAULT, STEVEN B

ART UNIT

PAPER NUMBER

2179

NOTIFICATION DATE

DELIVERY MODE

10/08/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| | | | |
|------------------------------|--|-------------------------------------|--|
| Office Action Summary | Application No. 10/606,410 | Applicant(s) MUNRO ET AL. | |
| | Examiner STEVEN B. THERIAULT | Art Unit 2179 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This action is responsive to the following communications: RCE filed 8/13/2008.
2. Claims 1 -32 are pending in the case. Claims 1, 12, 22, and 32 are the independent claims. Claims 1-3, 5, 8, 12, 22 and 32 are the amended claims.

Claim Rejections - 35 USC § 102

3. **The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under

35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was

commonly owned at the time any inventions covered therein were made absent any evidence to

the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor

and invention dates of each claim that was not commonly owned at the time a later invention was

made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35

U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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4. **Claims 1-3, 9-14, 19-24, and 29-32 are rejected under 35 U.S.C. 102(e) as anticipated by Dettinger et al. U.S Patent No. 6947928 filed Feb 26, 2002 or, in the alternative, under 35 U.S.C. 103(a) as obvious over Dettinger in view of Beibesheimer et al. (hereinafter Beibesheimer) U.S. Patent Publication 20020152190 filed Feb. 7, 2001.**

4. **Claims 1-3, 9-14, 19-24, 29-32 are rejected under 35 U.S.C. 102(e) as being anticipated by**

In regard to **Independent claim 1**, Dettinger teaches a method to facilitate a search of a database utilizing multiple search criteria, the method comprising:

- Receiving first and second search criteria from a user (See column 6, lines 25-67 and Figure 4-5 and column 7, lines 40-50). Dettinger shows the user entering criteria into the system where the first is data of birth and the second is a gender.
- Presenting a search interface for the user, the first and second criteria being included within the search interface (See Figure 5). Dettinger shows the first and second criteria included in the interface (See middle under condition).
- Presenting ~~the user with~~ an option to the user through the search interface ~~selectively~~ to selectively include and exclude each of the first and second search criteria from a search query while retaining the first and second criteria within the search interface, the search query capable of being run against a database (See figure4-6 and column 1, lines 35-40). Dettinger expressly show presenting the user an option (See edit, delete and/or, not) to include or exclude the birthdate and gender from the search query and maintains the criteria in the interface 520 (See also figures 9-17, which several alternative options for including and excluding search criteria with options presented to the user).

In the alternative, if the “presenting options to selectively include and exclude each of the first and

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second search criteria from a search query while retaining the first and second criteria within the search interface “limitation cannot be interpreted as presenting options to select and unselect criteria to include and exclude from the query, then the teachings of Beibesheimer can be relied upon in the alternative. Beibesheimer clearly shows an interface for selecting search criteria in a similar manner as presented in Dettinger. Beibesheimer shows the user can include and exclude criteria from the query while maintaining the criteria on the interface. For example, Figure 5 shows the user can select from the workspace interface options to include and exclude parameters from a search query (See also Para 65-67). Thus, a user can optimize a query by selecting the checkbox in the include or exclude section and the query will be optimized based on the presented user option and selection.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention, having the teachings of Dettinger and Beibesheimer in front of them, to modify in the alternative the system of Dettinger to explicitly show the include and exclude features of Beibesheimer. The motivation comes first from Dettinger where Dettinger states that “an additional number of interfaces may be needed for more complicated conditions such as ranges” (See column 7, lines 1-12). Second, Beibesheimer suggests that a major limitation of the prior art approaches is their inability to adaptively respond to the **same search** query by the same user over time based on changes in user context and history of prior interaction with the **search and selection system** (See Para 13). Coupled with the workspace interface it is clear that the intent of the interface is to provide options to the user to include and exclude parameters and to keep the parameter listings on the interface to allow the user to reselect them at a future date (See figure 5 and Para 49).

With respect to **dependent claim 2**, Dettinger teaches the method further comprising conducting a search of the database utilizing the search query, the search query including at least one of the first and second search criteria as included by the user (See column 8, lines 20-23 and figure 7).

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With respect to **dependent claim 3**, Dettinger teaches the method further comprising: presenting a search interface to the user to receive the first and the second search criteria, the search interface providing the user with a limitation option to limit a scope of any search query including the first search criteria; monitoring selection of the limitation option by the user; and monitoring an indication from the user that indicates inclusion or exclusion of each of the first and second search criteria within the search query (See column 7, lines 50-67 and column 8, lines 1-15 and figure 7). Dettinger teaches presenting the user with the date of birth and gender criteria and then allowing the user to and/or the queries together and then selects the group function. The interface monitors the selection because it displays the selections in the search summary area.

With respect to **dependent claim 9**, Dettinger teaches the method wherein the first search criteria is a keyword that identifies at least one category of listings included within the database, and the second search criteria is an attribute associated with a listing stored in the database (See Figure 2 and column 6, lines 15-57, data of birth and gender can be considered a keyword and attribute of a person listed in a database).

With respect to **dependent claim 10**, Dettinger teaches the method wherein the first search criteria is a keyword that identifies at least one category of listings included within the database, and the second search criteria identifies at least one sub-category of the at least one category (See column 6, lines 15-57 and column 7, lines 5-50).

With respect to **dependent claim 11**, Dettinger teaches the method wherein the search interface maintains a display of each of the first and second search criteria, regardless of whether the first and second search criteria are each selected by the user to be included within the search query (See column 6, lines 15-57 and column 7, lines 5-50).

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In regard to **Claims 12-14, 19-21**, claims 12-14, 19-21 reflect the medium comprising computer readable instructions for performing the steps of method claims 1-3, 9-11 respectively, and are rejected along the same rationale.

In regard to **Claims 22-24, 29-31**, claims 22-24, 29-31 reflect the system comprising computer readable instructions for performing the steps of method claims 1-3, 9-11, respectively, and are rejected along the same rationale.

In regard to **Independent claim 32**, Dettinger teaches a system to facilitate searching of a database using multiple search criteria, the system including:

- Means to receive first and second search criteria from a user (See column 6, lines 25-67 and Figure 4-5 and column 7, lines 40-50). Dettinger shows the user entering criteria into the system where the first is data of birth and the second is a gender.
- Means to present a search interface for the user, the first and second criteria being included within the search interface (See Figure 5). Dettinger shows the first and second criteria included in the interface (See middle under condition).
- Means to presenting ~~the user with~~ an option to the user through the search interface ~~selectively to~~ selectively include and exclude each of the first and second search criteria from a search query while retaining the first and second criteria within the search interface, the search query capable of being run against a database (See figure4-6 and column 1, lines 35-40). Dettinger expressly show presenting the user an option (See edit, delete and/or, not) to include or exclude the birth date and gender from the search query and maintains the criteria in the interface 520 (See also figures 9-17, which several alternative options for including and excluding search criteria with options presented to the user).

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Claim Rejections - 35 USC § 103

6. **The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. **Claims 4-8, 15-18, 25-28 are rejected under 35 U.S.C. 103(a) as being obvious over Dettinger et al. U.S Patent No. 6947928 filed Feb 26, 2002, in view of Beibesheimer et al. (hereinafter Beibesheimer) U.S. Patent Publication 20020152190 filed Feb. 7, 2001 and in further view of Monahan et al. U.S Patent No. 6523037 issued Feb. 18, 2003 and filed Sept 22, 2000.**

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The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

With respect to **dependent claim 4**, as indicated in the above discussion Dettinger teaches each limitation of claim 3.

Dettinger in view of Beibesheimer does not expressly teach the method wherein the database forms part of a network-based commerce facility. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Monahan, because Monahan teaches a database that presents user selectable search fields where the database is connected to an e-commerce network (See Figure 1, database server implemented in an auction facility and Figure 12c and 13). Monahan specifically teaches search engines provide mechanisms to allow users to select items of interest to them. In Dettinger the items of interest are shown to be items in a hierarchical database and provides a mechanism to organize the search terms. The difference in Monahan is that the items are in a hierarchical database of items for auction. Monahan suggests the system can provide users to select items and create a subset of

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the terms listed in the database (See column 7, liens 12-55) in other items than just an auction facility (See column 3, liens 30-35).

With respect to **dependent claims 5-8**, as indicated in the above discussion, Dettinger in view Beibesheimer in further view of Monahan teaches every element of claim 4.

Dettinger teaches the method where the first and the second search criteria are entered by a user (See Figure 2 and column 6, lines 25-37). Dettinger also teaches a first search criteria section for receiving the first search criteria from the user (See Figure 2, data of birth); and a second search criteria section for receiving the second search criteria from the user (See gender = male), and wherein the second search criteria section provides a plurality of optional search criteria at least one of which is selectable by the user to define the second search criteria (See Figure 5, edit, and, not, delete options to group) and responsive to a first search request from the user conducting a search of the database, and wherein the first search query includes the first search criteria but not the second search criteria (See Figure 5, 524 user can select which items to group or include, which can include the first, and not the second and visa versa as shown in figures 9-15) and responsive to a second search request from the user, wherein the second search query includes both the first and the second search criteria; and responsive to a third search request from the user, wherein the third search query includes the second search criteria but not the first search criteria conducting a search of the database (See Figure 5, 524 user can select which items to group or include, which can include the first, and not the second and the third and visa versa as shown in figures 9-15)

Dettinger does expressly teach that the wherein the network-based commerce facility is a network-based auction facility and the products are associated with listings of products up for auction on the auction facility and does not teach the second search criteria being associated with one of a plurality of categories in which listings are arranged and conducting a first search of the database to locate listings based on a first search query and conducting a second search of the database to locate listings based on a second search query, and conducting a third search of the

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database to locate listings based on a third search query. However, these limitations would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Monahan, because Monahan teaches a database that presents user selectable search fields where the database is connected to an e-commerce network (See Figure 1, database server implemented in an auction facility and Figure 12c and 13). Monahan specifically teaches search engines provide mechanisms to allow users to select items of interest to them and the items are products for sale. Monahan teaches the user can select items on figure 13 where the first search query can be big cats listed for sale on a particular website and none of the other items and then the user selects save search results. Second the user can now view the previous results (see column 4, lines 30-40) and select another item such as small cats on another website and then save again. The user can then deselect or delete the big cats and perform the search again and save. The user can perform this operation several times including and excluding any number of items listed in the search result screen. Monahan and Dettinger are analogous art because they allow the user to see previously created search strings and to select and deselect terms from the result sets. The motivation to combine comes from the suggestion in Monahan to provide the system users with options to select items and create a subset of the terms listed in the database (See column 7, lines 12-55) in other items than just an auction facility (See column 3, lines 30-35).

In regard to **Claims 15 - 18**, claims 15-18 reflect the medium comprising computer readable instructions for performing the steps of method claims 4-6, and 8, respectively, and are rejected along the same rationale.

In regard to **Claims 25-28**, claims 25-28 reflect the system comprising computer readable instructions for performing the steps of method claims 4-6, and 8, respectively, and are rejected along the same rationale.

It is noted that any citation to specific pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting

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in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)).

Response to Arguments

7. Applicant's arguments with respect to claims 1-32 have been considered but are not persuasive and an alternative rejection has been presented.

Nonetheless the following discussion could forward prosecution by clearly outlining the basis for the rejection. It is understood how the applicant can interpret Dettinger as such that the interface performs a search while including or excluding the first and second criteria and maintaining the criteria on the display as argued (See arguments page 10). However, one simple feature has been omitted from claim 1 and 12, 22, and 32. Each of the claims appear to recite presenting options to the user through the search interface to selectively include and exclude each of the first and second criteria from the search query while retaining the first and second criteria within the interface. It appears from Dettinger that the interface does exactly that where the options are presented to select the first and second criteria and the criteria are maintained within the interface. The claim further states the query is capable to run against a database but doesn't actually state that the search is run. Claim 2 recites that feature but limits the search to including the first and second criteria. Therefore, simply stated the Examiner must not import limitations from the specification into the claim per MPEP 2111.01 and the plain meaning of the claim recites **presenting an option** to the user to selectively include and exclude criteria while retaining the first and second criteria in the interface and Figure 5 for example shows the retained first and second criteria in the interface "refresh search summary" section after the user has selected options in the search conditions sections. The edit, delete and add, group and ungroup options allow the user to include or exclude the criteria. Once again the claims 1, 12, 22 and 32 do not recite actually running the query. While other dependent claims do recite the functions, for example claim 8, in each scenario when the user makes the actual choice to include or exclude

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the criteria between each step such as a third search where the search includes the second but not the first, a simple explanation is that the user selects options on the interface 5 to group and ungroup options to search.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEVEN B. THERIAULT whose telephone number is (571)272-5867. The examiner can normally be reached on Mon.-Fri. 10 am - 7 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Steven B Theriault/
Examiner
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